

Serial No.: 09/994,672
Atty. Docket No.: Weissman.US
Reply to Office Action of July 27, 2006

REMARKS

In view of the above amendments and following remarks, favorable reconsideration in this application is respectfully requested.

Telephone Interview

A telephone interview was conducted on November 27, 2006 with Examiner Tran and his primary. During the interview, the rejection under 35 U.S.C. §101 of claims 1-4, 6-11, 14-18 and 29 as directed to non-statutory subject matter was discussed. The changes suggested by the Examiners to overcome the rejection have been incorporated into the amended claims. Accordingly, it is respectfully submitted that the application is in condition for allowance.

Rejection – 35 U.S.C. §101

As noted in the prior Amendment, Applicant respectfully submits that the Examiner's interpretation of the MPEP and the Interim Guidelines is inaccurate. As stated in the Interim Guidelines (italics and bolding are added, underlining in original and citations omitted):

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “*functional descriptive material*” consists of data structures and *computer programs* which impart functionality when employed as a computer component. ... “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data.

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Based on the Interim Guidelines, the present invention is not “nonfunctional descriptive material,” such as music, literary works, or mere arrangement of data. Rather, it is “functional descriptive material,” which includes “computer programs.”

The Interim Guidelines then go on to state that:

Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. *When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. ...*

Thus, the Interim Guidelines clearly provide that “functional descriptive material,” such as the claimed computer program, is statutory in most cases. Accordingly, the Examiner does not have any support for the statement that the Interim Guidelines provide that computer programs are non-statutory. The MPEP provides similar statements and therefore also fails to support the Examiner’s statements.

Applicant notes that the Interim Guidelines also state (emphasis added):

When *nonfunctional descriptive material* is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is *not statutory* since no requisite functionality is present to satisfy the practical application requirement. *Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. ...* Such a result would exalt form over substance. ... Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk.

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Protection for this type of work is provided under the copyright law.

When *nonfunctional descriptive material* is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. § 101. ...

It is believed that the Examiner did not distinguish between nonfunctional descriptive material and functional descriptive material in setting forth the rejection. The Interim Guidelines and the MPEP are merely stating that claiming nonfunctional descriptive material as a computer or computer program does not render that non-statutory material to be statutory. Since that is not the present case, the Interim Guidelines and MPEP do not support the Examiner's conclusions.

Because the Examiner did not particularly set forth the rejection as that that the present invention is not an exception to the "most cases" of statutory functional descriptive material, or that it is nonfunctional descriptive material, Applicant requests that the Examiner make any additional rejection under §101 non-final to provide the Applicant with an opportunity to more fully respond to any such rejection.

It is respectfully submitted that the remaining rejection of claims 1-4, 6-11, 14-18 and 29 have been overcome and the application should be in condition for allowance together with allowed claims 12-13 and 19.

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In the event there are any questions relating to this Amendment or to the application in general, it would be appreciated if the Examiner would telephone the undersigned concerning such questions so that the prosecution of this application may be expedited.

Respectfully submitted,

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